

difficult to accurately read. No new matter is included and the amendment is supported by the remaining Figs. and the specifications. A Request For Approval of Proposed Drawing Changes is submitted herewith as a separate paper as required under 37 C.F.R. §1.121 along with new formal drawings.

#### REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-30 are presently pending before the Office. No claims have been canceled. Applicant has amended the specification, the claims and the drawings, and has further added new Claims 12-30. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed April 4, 2002 (Paper No. 2) and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

Relying on 35 U.S.C. §103(a), the Examiner has rejected the subject matter of claims 1 and 9 as obvious over Alber and Claims 2-4 and 7-8 as obvious over Alber in view of Wolf. Applicant respectfully traverses the rejection and requests reconsideration.

It is evident that Applicant's invention is decidedly different from the teachings of the Alber and Wolf patents. Applicant respectfully submits that the Examiner has misconstrued the Alber disclosure. At best, the board 29 and anchor device of the Alber disclosure by analogy, could arguably be said to be the equivalent of the weldment plate described in the present

invention. Of course, one can not weld to the board 29. However, the invention claims a device for supporting the weldment plate, a device that is placed into the form together with the weldment plate before any pouring of concrete takes place. The concrete finally anchors the weldment plate and inventive device together during the pouring.

The anchor of Alber is only partially inserted after the concrete is poured but before it cures. The anchor further does not include an elongated body portion. It is a V-shaped sheet metal material with outwardly directed flanges or ears having notches for bending and holes or notches for inserting nails or screws in a 2 by 4 stud or a plank board. The combined depth of the board and V-shaped anchor is significantly less than the combined inventive device and weldment plate.

In addition, although the V-shaped anchor may arguably have a depth it is not a length which is modified to be adjustable. The Examiner is referring to Col 2, lines 65-69 to assert that the reference disclosures adjustable length features. The disclosure section referred to by the Examiner is a description of Fig. 8 wherein Alber describes the ears being capable of being individually manufactured to accommodate nailing in different size boards such as single plate 2 by 4s, or double plate (stacked) 2 by 4s. This can be done in a number of ways, including multiple staggered holes in the ears and notches to facilitate bending and breaking of portions of the ears. If there is any adjustable interpretation, it is in the nature of adjusting the ears to have a meaty portion of the board to nail to. The section referred to by the Examiner lacks any disclosure for varying the length of the body portion inserted within the concrete itself.

Accordingly, the Alber reference teaches away from the invention as the Alber invention, which is the V-shaped anchor itself, is absolutely not adjustable in depth. Further, it is a V-shaped flat sheet metal stock, not an elongated body having a length.

Regarding the Wolf reference, there is absolutely no way to combine the telescoping sleeves of Wolf with the flat sheet metal stock formed in a V-shape of the Alber reference. To attempt such a combination is impossible and as such, the combined references teach away from the present invention.

Accordingly, the Examiner has not established a prima facie case of obviousness.

Clearly, in the absence of any suggestion or teaching whatsoever of how one skilled in the art would attempt to combine the cited references to produce the present invention, one skilled in the art would certainly not find ample motivation to use the Alber reference in the first instance or to use the Alber reference in combination with the Wolf reference to arrive at the present invention.

The Office has used the claimed invention as a reference against itself as if it had preceded itself in time. Legal authority invalidates such an analytical or reverse engineering approach to patent examination. It is not Applicant's burden to refute the Office's position that it would have been obvious to one of ordinary skill in this art at the time this invention was made to arrive at the present invention in view of the cited references. It is the burden of the Office to show some teaching or suggestion in the reference to support this allegation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d at 1051, 5 U.S.P.Q.2d at 1438-39 (Fed. Cir. 1988).

A finding by the Office that a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made based merely upon finding similar elements in a prior art reference would be "contrary to statute and would defeat the congressional purpose in enacting Title 35." Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593 at 1605 (Fed. Cir. 1987).

In addition, Applicant respectfully submits that the Examiner's legal reasoning is flawed. The knowledge of those skilled in the art is derived from the prior art, not from the Examiner's mental impression of what those skilled in the art might or might not know. It is the law as evidenced in Graham v. John Deere that is controlling. As enunciated by the Graham court, §103(a) requires a comparison of the claimed invention with the teachings of the prior art. Otherwise, the PTO could simply say "I'm skilled in the art. That claim is obvious." The rules and the law require that the Examiner point out where in the prior art lies applicant's claimed invention in the context of what those skilled in the art know. If it is not there, the public is not in possession of the invention, and, therefore, a rejection under 35 U.S.C. §103(a) will not lie.

There is no reasonable intrinsic or extrinsic justification for the proposed combination or modification. Accordingly, Applicant respectfully submits that original Claims 1-11 are patentable over the cited references under 35 U.S.C. §103(a). Withdrawal of the rejection is respectfully requested.

Nevertheless, in order to advance the case to allowance, Applicant has amended Claim 1 to increase its specificity of language. Claims 1-30 are patentable over the art of record. Accordingly, withdrawal of the rejection is respectfully requested.

#### **ALLOWABLE SUBJECT MATTER**

The Examiner has indicated that Claims 5, 6, 10 and 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and the intervening claims. Applicant thanks the Examiner for indicating allowable subject matter. Accordingly, independent Claim 12 is reflective of rewritten Claim 5, independent Claim 19 is reflective of rewritten Claim 6, and independent Claim 23 is reflective of rewritten Claim 10.

### CONCLUSION

As the Federal Circuit observed in Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 217 U.S.P.Q. 193 (Fed. Cir. 1983):

The question of nonobviousness is a simple one to ask, but difficult to answer ... The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness ...

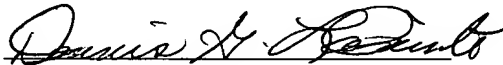
Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

Dated: 4/22/02

  
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**MARKED-UP VERSION OF AMENDED**  
**SPECIFICATION PARAGRAPHS**

A

The device of the present invention comprises a spacer/support that engages the support surface on which the concrete wall is poured and a weldment plate holding it in the desired position relative to that surface during the curing of the concrete. The spacer/support comprises [a] an elongate body portion having a length substantially equal to the thickness of the concrete wall minus a dimension of the weldment extending in the direction of the thickness of the concrete wall; a surface engaging portion for contacting the surface on which the concrete wall is poured and supporting the weldment in a position appropriately spaced from that surface; means for attaching said body portion to the weldment; whereby the weldment will be maintained in a desired position as wet concrete is poured and sets up.

Surface engaging portion 24 preferably comes to a point 25 so as to minimize the amount of weldment spacer/support that protrudes on surface 21. Accordingly, minimal accommodation will be necessary to treat the points 25 on wall 18. In fact, it is anticipated that the painting, papering or other treatment provided wall surface 21 will adequately cover the points 25. It is preferred that the length of body portion 22 will be adjustable. One such means can be the cutting of body portion 22 to the desired length to place weldment plate 12 flush with the designed wall surface 19 once concrete 17 is poured. To facilitate this cutting (or breaking), body 22 may be provided with scoring lines [28] 40 at one or more conventional wall thicknesses/stud lengths so the point 25 may be maintained.



A second embodiment of weldment plate spacer/support is shown in Fig. 4 generally at 20'. In this embodiment, body portion 22' is formed by a first component 32' and a second component 34' that can be longitudinally moved with respect to each other to vary the length, as desired. This variation in length is effected by rotating one of the components 32', 34' with respect to the other. The complementarily engaged threads 33' and 35' will produce the desired variation in length. The head 31' of first component 32' is designed for attachment to a weldment plate 12 that has no projections. An adhesive 37', such as LIQUID NAILS may be used to secure the spacer/support 20' to the surface 13 of weldment plate 12. A minimum of three spacer/supports 20' dispersed in a triangular pattern will be needed to assure stable placement of the weldment plate 12.